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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,115	08/30/2003	James J. O'Connor	0020-3 CIP	1836

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EXAMINER

JAGAN, MIRELLYS

ART UNIT PAPER NUMBER

2859

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/652,115

Applicant(s)

O'CONNOR, JAMES J.

Examiner

Mirellys Jagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent 5,072,523 to Bennett in view of U.S. Patent 5,222,303 to Jardine, U.S. Patent 5,361,509 to Wheeler, Sr. et al [hereinafter Wheeler], U.S. Patent 5,509,212 to Henricksen, and U.S. Patent 5,598,638 to Plesh.

Bennett discloses an apparatus comprising:

a substantially flat elongated body (16) with first and second ends, front and back sides, and a longitudinal axis;

a first horizontal slot, e.g., at 32 in figure 2, disposed on the body at a first location and arranged perpendicularly to the axis for determining placement of an outlet box in accordance with a selected standard or code;

a second horizontal slot disposed on the body at a second location and arranged perpendicularly to the axis for determining placement of an outlet box in accordance with a selected standard or code; and

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a third horizontal slot disposed on the body at a third location and arranged perpendicularly to the axis for determining placement of standard wall switches in accordance with a selected standard or code (see figure 6).

Bennett teaches that the slots are located at different locations along the body so that electrical boxes and switches can be placed at proper locations, i.e., standard locations.

Bennett does not disclose the apparatus having a level for vertically leveling the apparatus; a set of indicia located along each edge of the front side of the body for indicating the distance of the slots from the first end; the second slot being for determining placement of a counter-high outlet box; means for folding said substantially flat elongated body for easy transportation; and the apparatus having a length of about 6 feet and a width of 2-4 inches.

Jardine discloses a measuring apparatus for locating the position of an electrical box. The apparatus has a level (26) thereon for properly positioning the apparatus vertically to allow accurate positioning of the box, and indicia along an edge of the front side of the body for indicating distance from a first end.

Wheeler discloses that it is known to provide an outlet box at a counter-high level (see column 6, lines 41-44).

Henricksen discloses a template comprising a flat elongated body, the template having hinges for folding the template for easy transportation.

Plesh discloses an apparatus for marking the location of electrical boxes on a wall. The apparatus has an elongated body for determining placement of a box above a floor in accordance with desired standards such that a single box may be located at different heights that are unrelated to each other. The length of the body is between 4 to about 6 feet and the width of a

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first end of the body is 2-4 inches in order to place a box vertically along the length of a wall or stud (see figure 1; and column 4, lines 55-60).

Referring to claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Bennett by adding a level to the apparatus and indicia along a front edge of the body, as taught by Jardine, in order to properly position the apparatus vertically when positioning an electrical box, and in order to visually determine the height of a particular slot to position a box in a desired and proper location from the floor.

Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Bennett by locating the second slot to determine placement of a counter-high outlet box since Wheeler teaches that it is known in the art to provide an outlet box at a counter-high level.

In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Bennett by providing folding means, i.e., hinges, as taught by Henricksen, along the sides of the bodies (16) in order to fold them inward in order to flatten the apparatus for easy transportation.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Bennett by making the body having a length of about 6 feet and a width of a first end of 2-4 inches, as taught by Plesh, in order to place a box vertically along the length of a wall or stud.

Lastly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Bennett, Jardine, Wheeler, Henricksen, and Plesh

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by providing indicia on both edges of the body in order to determine the distance of all of the slots from the floor, and since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett, Jardine, Wheeler, Henricksen, and Plesh, as applied to claims 1 and 5 above, and further in view of U.S. Patent 2,713,203 to Gottlieb.

Bennett, Jardine, Wheeler, Henricksen, and Plesh disclose an apparatus having all of the limitations of claim 2, as stated above in paragraph 2, except for the apparatus having a textual portion of a code or standard.

Gottlieb discloses a measuring apparatus for marking and locating the position a line conforming to building laws and other requirements [i.e., codes and standards] for marking a straight line. The apparatus may have text for indicating instructions and guidelines to allow an inexperienced individual using the apparatus to conform to building laws and other requirements [i.e., codes and standards](see column 3, line 68-column 4, line 10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Bennett, Jardine, Wheeler, Henricksen, and Plesh by adding a textual portion of the standard or codes on the apparatus since Gottlieb teaches that providing a text of building laws or other requirements is beneficial since it allows an inexperienced individual using the apparatus to conform to building laws and other requirements.

Allowable Subject Matter

4. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or suggest the following in combination with the remaining limitations of the claims:

An integrated electrician's measuring apparatus for marking and locating the position of outlet boxes, counter height outlets, and standard wall switches, wherein said means for folding comprises at least one hinge spanning the width of the substantially flat elongated body (see claim 9).

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mirellys Jagan whose telephone number is 571-272-2247. The examiner can normally be reached on Monday-Friday from 11AM to 4PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ

October 23, 2006


Mirellys Jagan
Patent Examiner
Technology Center 2800